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13 UNITED STATES DISTRICT COURT
14 CENTRAL DISTRICT OF CALIFORNIA
15

16 JAMES R. GLIDEWELL DENTAL
CERAMICS, INC. DBA
17 GLIDEWELL LABORATORIES, a
California corporation,
18 Plaintiff,
19 v.

20 KEATING DENTAL ARTS, INC., a
California corporation,
21 Defendant.

22 KEATING DENTAL ARTS, INC., a
California corporation,
23 Counter-Plaintiff,
24 v.

25 JAMES R. GLIDEWELL DENTAL
CERAMICS, INC., DBA
26 GLIDEWELL LABORATORIES, a
California corporation, and DOES 1
27 THROUGH 5, inclusive,
28 Defendant.

Case No. SACV11-01309-DOC(ANx)

Hon. David O. Carter

**Ex Parte Application to Amend the
Scheduling Order; Memorandum of
Point and Authorities in Support
Thereof;**

Complaint Filed: August 30, 2011

1 TO THE DISTRICT COURT AND PARTIES IN INTEREST:

2 PLEASE TAKE NOTICE that, by submission to the Honorable David O.
3 Carter of the United States District Court for the Central District of California,
4 Plaintiff and Counter-Defendant James R. Glidewell Dental Ceramics, Inc.
5 (“Glidewell”) hereby applies *ex parte* to continue the Scheduling Order deadlines
6 and dates for approximately two months.

7 Glidewell is cognizant of the seriousness with which this Court takes its
8 Scheduling Orders, and does not request this continuance lightly. However,
9 Glidewell believes that there are sufficient grounds on which to request that the
10 Court provide it a reasonable continuance here. Those reasons are:

11 1. Defendant and Counter-Plaintiff Keating Dental Arts, Inc. (“Keating”)
12 recently amended its initial disclosures twice – once on September 27, 2012, and a
13 second time on October 19, 2012 – adding 13 additional witnesses on a variety of
14 topics; an additional topic of testimony for 13 different previously-identified
15 witnesses; and two new, broadly phrased categories of documents. Glidewell
16 should be given an opportunity to take discovery on these disclosures.

17 2. On October 10, 2012, Keating was granted leave by the Court to
18 amend its answer to assert a new counterclaim (fourth counterclaim) for
19 cancellation of Glidewell’s Trademark Registration No. 3,739,663. Glidewell
20 respectfully asks that the Court consider the fact that it permitted Keating to file this
21 amended pleading long after the deadline for filing amended pleadings had passed.
22 Just as Keating was permitted to assert its new counterclaim after the pertinent
23 deadline had passed, Glidewell should be given a reasonable opportunity to conduct
24 discovery regarding the new counterclaim.

25 3. On October 29, 2012, Glidewell substituted Snell & Wilmer LLP in as
26 counsel of record in this case, replacing its prior counsel, Leonard Tachner. Snell
27 & Wilmer was first engaged late in the afternoon on October 25, i.e., Thursday of
28 last week, and has been diligently working to review the case file and materials.

1 Unfortunately, it appears that Glidewell's prior counsel was less than diligent in
2 prosecuting this action, and failed to even raise the topic of obtaining a survey
3 regarding Keating's allegation that the BRUXZIR mark is generic, or of obtaining a
4 report from an industry-focused expert regarding the issue of whether BRUXZIR
5 mark is generic, or of deposing any of the more than 20 dentists that Keating
6 identified as persons with knowledge regarding the issue of whether BRUXZIR
7 mark is generic. Accordingly, Glidewell respectfully requests that this Court
8 provide it a modest continuance in order to enable Glidewell to cure its prior
9 counsel's lack of diligence so this case may be litigated on the merits rather than on
10 the basis of its prior counsel's deficient performance.

11 4. The short continuance requested will not prejudice Keating. It is
12 highly unlikely that any witnesses will become unavailable, or that any
13 documentary evidence will be lost, as a result of the requested continuance.

14 As a result, Glidewell seeks the following deadlines set by the Court's
15 Scheduling Order be extended as follows:

16	Discovery Cut-off	12-23-12
17	(Dispositive) Motion Cut-Off	02-15-13
18	Setting Final Pre-Trial Conference (8:30 a.m.)	03-28-13
19	Jury Trial (8:30 a.m.)	04-23-13

20 Glidewell makes this application on an *ex parte* basis because the current
21 discovery cut-off date is October 29, 2012, and thus a noticed motion could not be
22 heard prior to that date. The need for this application came to light as a result of the
23 involvement of Glidewell's new counsel; accordingly, Glidewell has made this
24 request as expeditiously as possible.

25 In accordance with L.R. 7-19 and 17-19.1, the name, address, telephone
26 number and e-mail address of Keating's counsel is as follows:

27 Lynda J. Zadra-Symes (lynda.Zadra-Symes@kmob.com)

28 Jeffrey L. Van Hoosear (jeffrey.vanhoosear@kmob.com)

1 Knobbe, Martens, Olson & Bear, LLP,
2 2040 Main Street, Fourteenth Floor,
3 Irvine, CA 92614,
4 Phone: (949) 760-0404

5 As set forth in the attached declaration of Phillip J. Graves, Glidewell's
6 counsel informed Keating's counsel of intention to file this Application on October
7 29, 2012. Keating's counsel intends to oppose this application.

8 This Application is made pursuant to L.R. 7-19, and is based on and
9 supported by this Notice of *Ex Parte* Application and *Ex Parte* Application, the
10 attached Memorandum of Points and Authorities, and the concurrently filed
11 declarations of Philip J. Graves, Leonard Tachner, and Keith D. Allred.

12
13 Dated: October 29, 2012

SNELL & WILMER L.L.P.

14
15 By: s/Philip Graves

16 Philip Graves
17 Greer Shaw
18 Christopher B. Pinzon
19 Colin R. Higgins
20 Attorneys for Plaintiff
21 JAMES R. GLIDEWELL DENTAL
22 CERAMICS, INC. DBA
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MEMORANDUM OF POINTS AND AUTHORITIES

Plaintiff and Counter-Defendant James R. Glidewell Dental Ceramics, Inc. (“Glidewell”) brings this motion to amend the Scheduling Order for the purpose of conducting additional discovery. Three recent developments warrant extending the discovery cutoff by two months.

First, Defendant and Counter-Plaintiff Keating Dental Arts, Inc. (“Keating”) recently amended its initial disclosures twice – once on September 27, 2012, and a second time on October 19th – adding 13 additional witnesses on a variety of topics; an additional topic of testimony for 13 different previously-identified witnesses; and two new, broadly phrased categories of documents. Glidewell should be given an opportunity to take discovery on these disclosures.

Second, on October 10, 2012, Keating amended its counterclaims to include a new counterclaim for cancellation of Glidewell’s U.S. Trademark Registration No. 3,739,663 for the mark BRUXZIR. That amendment occurred too close to the discovery cutoff to conduct adequate discovery on the new counterclaim. Glidewell should be given an opportunity to do so.

Third, on October 29, 2012, Glidewell substituted Snell & Wilmer LLP in as counsel of record in this case, replacing its prior counsel, Leonard Tachner. Snell & Wilmer was first engaged late in the afternoon on October 25, i.e., Thursday of last week, and has been diligently working to review the case file and materials. Unfortunately, it appears that Glidewell’s prior counsel was less than diligent in prosecuting this action, and failed to even raise the topic of obtaining a survey regarding Keating’s allegation that the BRUXZIR mark is generic, or of obtaining a report from an industry-focused expert regarding the issue of whether BRUXZIR mark is generic, or of deposing any of the more than 20 dentists that Keating identified as persons with knowledge regarding the issue of whether BRUXZIR mark is generic. Accordingly, Glidewell respectfully requests that this Court provide it a modest continuance in order to enable Glidewell to cure its prior

1 counsel's lack of diligence so this case may be litigated on the merits rather than on
2 the basis of its prior counsel's deficient performance.

3 Finally, the short continuance requested will not prejudice Keating. It is
4 highly unlikely that any witnesses will become unavailable, or that any
5 documentary evidence will be lost, as a result of the requested continuance.
6 Glidewell, therefore, respectfully requests that the Court grant this motion.

7 **I. Good Cause Exists to Amend the Scheduling Order**

8 Rule 16(b) provides that the "scheduling order shall not be modified except
9 by leave of court and upon a showing of good cause." Fed.R.Civ.Proc. 16(b). "This
10 'good cause' standard primarily considers the diligence of the party seeking the
11 amendment." *Johnson v. Mammoth Recreations, Inc.*, 975 F.2d 604, 609 (9th Cir.
12 1992) (internal quotation marks omitted).

13 **A. Glidewell Should be Granted an Opportunity to take Discovery on**
14 **Keating's Recent and Material Amendments to its Initial**
15 **Disclosures**

16 On September 27, 2012, scarcely more than a month before the current
17 discovery cutoff, Keating materially amended its initial disclosures. [Declaration of
18 Phillip Graves ("Graves Decl.") ¶4, Ex. B.] Keating added eleven new witnesses,
19 including Dr. Gary P. Tobin, Dr. Jenny Harris, Dr. Joseph Ting, Dr. Raymond
20 Brady, Dr. Michael Colleran, Dr. Richard Scott, Dr. Daniel Sweet, Dr. George
21 Tashiro, Dr. Thomas Nussear, Dr. Carol Frattura, and Dr. David Eggleston (an
22 expert). [Compare *Id.* Ex. A with Ex. B.] The topics of the testimony range from
23 the absence of confusion between the parties' marks, the alleged generic nature of
24 the marks, Glidewell's demands to cease using its mark, and expert testimony on
25 the use of "bruxer" and related terms in the dental industry. [*Ibid.*] Keating also
26 added an additional topic of testimony, "use of bruxer crown," to 13 previously
27 identified witnesses. [*Ibid.*]

28 Then, on October 19, 2012 – just 10 days before the discovery cutoff –

1 Keating added two new witnesses, Lori Boatright (an expert witness) and Scott
 2 Hudson. [Compare *Id.* Ex. B with Ex. C.] Boatright is to offer expert testimony
 3 regarding USPTO rules and procedures, the USPTO's examination of Glidewell's
 4 Bruxzir mark, and the validity of Glidewell's Bruxzir mark. [*Ibid.*] Scott Hudson
 5 is to testify regarding Glidewell's enforcement efforts associated with the Bruxzir
 6 mark, and language used by the dental industry. [*Ibid.*] At the same time, Keating
 7 added two broad new categories of documents it intends to rely on at trial:
 8 documents regarding "advertisements by third parties showing the offering for sale,
 9 and sale, of commercially available products for the dental industry using brand
 10 names that include 'Brux,' 'Zir' or variations thereon"; and documents regarding
 11 "advertisements by dental laboratories, including dental laboratories that do
 12 business with Glidewell Laboratories, showing the offering for sale, and sale, of
 13 full contour zirconia crowns that do not originate from Glidewell." [*Ibid.*] Keating
 14 then served the belatedly-disclosed Boatright expert report on October 15th—two
 15 weeks before the discovery cutoff, and during a period during which, between
 16 Glidewell and Keating, nine depositions were scheduled. [Declaration of Leonard
 17 Tachner ¶ 2.]

18 As one commentator states, "When the modification [of the scheduling
 19 order] is necessitated by acts of the opposing party or by the opponent's failure to
 20 act, relief also has been deemed appropriate." Wright, et. al., 6A Federal Practice
 21 and Procedure § 1522.2 (3d ed.). That is what occurred here. On the eve of the
 22 discovery cutoff, Keating materially added to, and altered, the witnesses and
 23 evidence it intends to rely on at trial. While Glidewell does not contend that
 24 Keating erred in proffering its late-stage discovery – Glidewell intends to serve
 25 additional disclosures today – Glidewell does contend that Keating's decision to
 26 serve a raft of additional disclosures late in the day justifies a short continuance to
 27 take additional discovery. See *Nelson v. Safeco Ins. Co. of Illinois*, 2011 WL
 28 13848 (D. Nev. Jan. 4, 2011) (discovery cutoff extended where defendant amended

1 initial disclosures 10 days before discovery cutoff).

2 **B. Glidewell Should be Granted an Opportunity to Take Discovery**
 3 **on Keating's New Counterclaim**

4 On October 10, 2012 – about two and a half weeks before the discovery
 5 cutoff – Keating added a new counterclaim for cancellation of Glidewell's U.S.
 6 Trademark Registration No. 3,739,663. [Docket No. 65.] While of course
 7 Keating's motion for leave to file an amended answer and counterclaims was filed
 8 well in advance of that date, Glidewell could not be certain that it would be
 9 subjected to Keating's new counterclaim until the Court granted Keating's motion.
 10 Given the close proximity to the discovery cutoff, Glidewell had no meaningful
 11 opportunity to propound discovery concerning the new counterclaim. A
 12 continuance of the discovery cut-off date and trial date is appropriate when a
 13 defendant files a new counterclaim close to the discovery cut-off date. Glidewell
 14 submits that that is particularly the case here, where Keating requested and obtained
 15 leave to file an amended pleading long after the deadline to do so had passed.
 16 *Spellbound Dev. Group, Inc. v. Pac. Handy Cutter, Inc.*, 2011 WL 1810961 (C.D.
 17 Cal. May 12, 2011) (Carter, J.) (new counterclaim added shortly before discovery
 18 cutoff warranted amendment of scheduling order); *Wang Hartmann Gibbs &*
 19 *Cauley, PC v. Silver Point Capital, L.P.*, 2009 WL 3517674 (C.D. Cal. Oct. 26,
 20 2009) (Carter, J.) (same). That is what happened here. Accordingly, the Court
 21 should grant this motion to modify the scheduling order to permit additional
 22 discovery.

23 **C. A Short Extension of Discovery is Warranted to Permit**
 24 **Glidewell's New Counsel to Correct Deficiencies in Glidewell's**
 25 **Prior Counsel's Representation of the Client**

26 Glidewell retained Snell & Wilmer, L.L.P. just a few days ago, late in the
 27 afternoon on October 25, 2012. [Graves Decl. ¶ 2.] Snell & Wilmer moved
 28 quickly to obtain the case file from Glidewell's prior counsel and to review its

1 contents. [*Id.* ¶¶ 3-5.] Unfortunately, what Glidewell's new counsel learned is that
 2 the company's prior counsel appears to have failed to exercise reasonable diligence
 3 in prosecuting this action. Among other things, Glidewell's prior counsel:

- 4 • Failed to commission a survey concerning Keating's allegations that
 5 the BRUXZIR mark is generic or lacks secondary meaning, or
 6 concerning likelihood of confusion;
- 7 • Failed to secure a report from an industry-focused expert, such as a
 8 dentist, concerning Keating's allegations that the BRUXZIR mark is
 9 generic or lacks secondary meaning, or concerning likelihood of
 10 confusion;
- 11 • Failed to depose any of the more than 20 dentists that Keating
 12 identified – some of them, admittedly, very late in the day – with
 13 knowledge regarding Keating's allegation that the BRUXZIR mark is
 14 generic.

15 Glidewell acknowledges that the actions – and inaction – of counsel are
 16 generally imputed to the client. However, the circumstances of this case justify
 17 leniency in the application of this principle. Glidewell is unsophisticated with
 18 respect to intellectual property litigation – this is the company's first trademark
 19 infringement case, and the first trademark infringement case that its in-house
 20 counsel have supervised. [Declaration of Keith Allred, ¶ 2.] Mr. Tachner billed
 21 himself as an experienced trademark litigator, and Glidewell's in-house counsel
 22 relied exclusively on Mr. Tachner to guide them through this lawsuit. [*Id.* ¶¶ 3-4.]
 23 Yet, not only did Mr. Tachner fail to perform the work that he should have, he
 24 failed to even discuss the topics outlined above with Glidewell, his client. [*Id.* ¶ 5.]
 25 On these facts, Glidewell submits that it would be inequitable to charge it with the
 26 dereliction of its prior counsel, particularly in light of the fact that its prior counsel
 27 is a solo practitioner who is unlikely to have sufficient insurance coverage to
 28 respond fully to any malpractice award that Glidewell might recover in subsequent

1 collateral litigation.

2 It is within the Court's discretion to grant Glidewell the continuance that it
3 requests, and there are good reasons for the Court to exercise its discretion to
4 provide additional time for Glidewell to procure the evidence that will enable it to
5 make its best case at trial. This is not a sideshow for Glidewell – the products
6 protected under the registered BRUXZIR mark have generated revenues for the
7 company in excess of \$120 million over the past 3 ½ years, and are far and away
8 the most important product line for Glidewell. [Allred Decl. ¶ 6.]

9 All that Glidewell asks is that the Court provide it a reasonable opportunity
10 to adduce the evidence that its prior counsel should have obtained. There is no
11 unfair prejudice to Keating – it will have the same opportunity to take additional
12 discovery and obtain a survey, should it choose to do so. The requested
13 continuance is reasonable and short, only two months. And, by providing such a
14 continuance, this Court will enable the parties to present evidence that fully
15 addresses the merits of this case, involving the mark branding Glidewell's most
16 important product. If the mark were to be found to be generic – a case that Keating
17 will not, on the evidence, be able to make – it should only be after the parties have
18 made a full presentation on the merits, rather than a presentation hobbled by the
19 deficient preparation of Glidewell's former counsel.

20 **CONCLUSION**

21 For the foregoing reasons, Glidewell respectfully requests that this motion be
22 granted.

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1 Dated: October 29, 2012

SNELL & WILMER L.L.P.

2
3 By: s/Philip Graves

4 Philip Graves
5 Greer Shaw
6 Christopher B. Pinzon
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Glidewell Laboratories v. Keating Dental Arts, Inc.
United States District Court, Central, Case No. SACV11-01309-DOC (ANx)

CERTIFICATE OF SERVICE

I hereby certify that on October 29, 2012, I electronically filed the document described as **Ex Parte Application to Amend the Scheduling Order; Memorandum of Point and Authorities in Support Thereof** with the Clerk of the Court using the CM/ECF System which will send notification of such filing to the following:

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Dated: October 29, 2012

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